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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,049	07/30/2003	James A. Truc	82800ADAN	8183

7590 05/16/2005

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EXAMINER
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GRAY, DAVID M

ART UNIT	PAPER NUMBER
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2851

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/630,049

Applicant(s)

TRUC ET AL.

Examiner

David M. Gray

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02-25-2005</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

In view of the newly discovered prior art, PROSECUTION IS HEREBY REOPENED.

A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Wen, US Patent 5,797,688.

The acknowledged prior art of Wen fully meets the claimed invention, see col 1, ln 39 to col 2, ln 8, especially “However, the market has long needed the ability to print photographic images on the compact disc labels. For instance, for compact discs containing a plurality of

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photographic images, it is desirable to display thumbnail images on the label of the compact discs to serve as an index to the stored image content.”

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kahle in view of Kraft et al.

Applicant acknowledges Kahle discloses “providing identifying information which can identify, in general, the subject matter of the information on the disk.” Additionally Kahle discloses “at least a portion of the digital information that is stored at a storage location is transferred in the form of a digital data stream to the medium. Extracted from this data stream is title information. A visual label having the extracted title information thereon is placed on the recording medium. Preferably, the visual label will be directly printed on the recording medium,

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by ejecting ink from an [sic] laser or ink jet type printer” (Kahle col 2, lns 14-21). And Kahle defines the individual label as “a visual label that uniquely identifies the digital information which had been or will be transferred” (Kahle col 3, lns 58-64). And Kahle discloses “By a visual label is meant that title information on the label is human readable ... will uniquely identify the information recorded ... can include, but is not limited to ... a table of contents” (Kahle col 4, lns 8-18). Based on the cited passages applicant’s statement that Kahle “does not contemplate or suggest that the information in Kahle is to be positive images which directly represent or replicate in a visual manner information which is stored in digital form on the disk” appears to be incorrect. Finally Kahle discloses “the recording medium will be a recordable compact disk and the label will be printed only on a defined area of the compact disk. This area is located between an outer edge portion and an inner edge portion of a non-recordable surface of the disk” (Kahle col 2, lns 24-28).

Applicant statement that “Kraft et al. was cited to show the concept of an index print” is not correct. Kraft et al. was cited for teaching that an “index print is thus a kind of “table of contents” of a photo album and is especially customer-friendly for ordering reprints. For the future, and also in view of recent developments in the field of photographic materials and the increasing significance of video technology (such as photo CDs), it can therefore be expected that index prints will gain markedly greater significance and will become standard in photoprocessing” (Kraft et al. col 2, lns 5-12). Kraft et al. shows the index print 10 having images thereon in the well-known two-dimensional array in Figure 1.

Applicant attacks the reference individually to conclude “one of ordinary skill in the art would not have provided for the specific feature of the present invention where positive images

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are applied to a surface of a disk in the manner that the positive images directly represent the digital information stored on a second surface of the disk.” Kahle discloses providing a visual label having a table of contents that directly corresponds to the digital information on a disk. Kraft et al. teaches that, for photographic images, an index print is a table of contents. Therefore one of ordinary skill in the art having Kahle and Kraft et al. would readily see that if the contents of the disk of Kahle were photographic images, then an index print would be a desirable table of contents. One would have selected an index print so that the photographic images can be readily identified. In providing an index print on a label of a disk the two-dimensional array would have to be adapted to fit into the defined area of the compact disk for printing.

Claims 8-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Otake et al., Ishikawa et al. and Wess.

Applicant argues that the specific layout of the images is not taught by the combination of Otake et al., Ishikawa et al. and Wess. However, it is clear that providing the index print on the label of a disk would require that the index print be applied to the available area of the disk. Given such a constraint, it is clear that one of ordinary skill in the art would readily recognize that the index print images would be provided in a rectangular array that does not include the spindle area, or a radial array. Thus applicant's arguments are not convincing that the examiner is in error in determining that the arrangement of the index print on the surface of the disk is printed matter.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

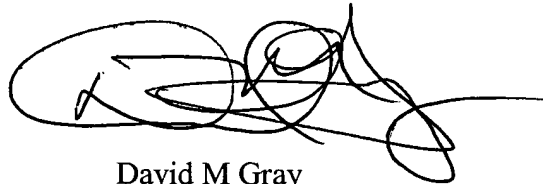
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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Gray whose telephone number is 571-272-2119. The examiner can normally be reached on M-T 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David M. Gray', with a long horizontal line extending to the right.

David M Gray  
Primary Examiner  
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